IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

     Simpson, et al.

Serial No.: 10/029,960

Filed: December 21, 2001

                                  Group Art Unit: 2137

                                  Examiner: Pyzocha, Michael

                                  Docket No. 10007659-1

For: **Document Notarization System and Method**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

     The Examiner's Answer mailed November 9, 2007 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

     It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

1.   New Rejection Under 35 U.S.C. § 101

For the first time during prosecution of the instant application, the Examiner now rejects claims 21-23 as being directed to non-statutory subject matter. Applicant objects to this belated rejection as clearly denying Applicant a full opportunity to respond. As provided in MPEP, "[t]he Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, *before appeal.*" MPEP § 706.07 (emphasis added). In this case, the Examiner had ample opportunity to make his rejection under 35 U.S.C. § 101 during normal prosecution but for whatever reason did not do so until *after* the case had entered appeal. The Examiner's delay in making the rejection has unfairly prejudiced Applicant given that Applicant cannot amend any of claims 21-23, if Applicant so chose, without reopening prosecution and effectively wasting the investments associated with filing the Notice of Appeal and preparing the Appeal Brief.

Applicant further notes that 37 C.F.R. § 41.39(a)(2) explicitly states that the circumstances in which an Examiner can present a new ground of rejection in an Examiner's Answer should be "rare." The Examiner has not provided any explanation as to why the rejection could not have been made during normal prosecution or why the

instant case is in some way exceptional so as to justify application of such a "rare" rejection.

In view of the above, Applicant respectfully submits that the Examiner's rejection should have been made prior to appeal and, therefore, that presenting the rejection for the first time in the Examiner's Answer is improper and/or unfairly prejudices Applicant. Applicant therefore respectfully requests that the rejection be overturned.

Turning to the merits of the rejection, Applicant notes that Applicant's claims are not merely "functional descriptive material" as alleged by the Examiner. Instead, the claims are directed to various logic that is "stored on a computer-readable medium". Although the Examiner has cryptically stated that the claimed computer-readable medium "includes non-statutory subject matter," the Examiner has provided no explanation as to why such a medium includes non-statutory subject matter. Therefore, the Examiner fails to state a proper rejection of claims 21-23 under 35 U.S.C. § 101. Applicant respectfully submits that the rejections should be withdrawn also for that reason.

2.   Applicant's Description of the Epstein Disclosure

On pages 7 and 8 of the Examiner's Answer, the Examiner criticizes Applicant's summary of the Epstein disclosure as "attempting to show" that Epstein fails to disclose retrieving image data to be notarized. In particular, the Examiner argues that the Examiner relies upon a different part of Epstein's disclosure and, therefore, Applicant should disregard the remainder of Epstein's disclosure. In reply, Applicant notes that Applicant described the teachings of the Epstein reference on pages 6 and 7 of the

Appeal Brief to provide a summary of Epstein's disclosure. Although Applicant understands the Examiner's desire to focus only on discrete portions of Epstein's disclosure that supports his rejections, Applicant believes that a determination of the patentability of Applicant's claims is best made with an understanding of Epstein's disclosure as a whole.

As a further point, Applicant notes the Examiner cites new portions of the Epstein disclosure in the Examiner's Answer to support his rejections of Applicant's claims. Therefore Applicant could not have anticipated which portions of the Epstein's disclosure upon which the Examiner would rely.

Finally, Applicant submits that the fact that the Examiner did not allege that Applicant's description of the Epstein disclosure on pages 6 and 7 of the Appeal Brief is incorrect is tantamount to an admission that Applicant's description of Epstein's disclosure is true and accurate.

3.   **Network-Based Notarization Service "Retrieving Imaging Data on Behalf of a User"**

As noted in the Appeal Brief, Epstein does not teach a "network-based notarization service" "retrieving imaging data on behalf of a user". As stated in the Appeal Brief, Epstein does not describe any service or other entity that "retrieves" anything "on behalf of a user".

On page 8 of the Examiner's Answer, the Examiner now argues, for the first time, that those limitations are taught in column 4, line 58 to column 5, line 14 of the Epstein disclosure. That portion of Epstein's disclosure provides as follows:

In the next portion of steps 190 in FIG. 2c, the server automatically revises the image and obtains a time stamp for the revision. In step 192, the server compresses the image into a lossy condensation. For example a bit image is compressed into a bit reduced image by JPEG compression, an audio image is compressed using MPEG-2 or Dolby AC3, or a video may be compressed using MPEG-2. In step 194, the server stores the condensation with relation to the image hash. In step 196, the server hashes condensation, and in step 198, the server combines the condensation hash and the notary's image signature, for example, by appending them together or more preferably by appending the image signature to the image and hashing them together in step 196. In step 199, the server encrypts the combination to form the server's condensation signature, and in step 200, the server stores the hash and server's condensation signature with relation to condensation. In step 201, the server obtains a time stamp from the notary for the servers condensation signature and stores the time stamp with relation to condensation. In step 202, server deletes image. This may be required because uncompressed images especially of video may require 100 times as much storage as compressed video, and such large amounts of storage may not be available or affordable by the customer.

Epstein, column 4, line 58 to column 5, line 14. As can be readily appreciated from the above excerpt, Epstein says *nothing* about any service "retrieving image data on behalf of a user". Perhaps this explains why the Examiner has neither identified which entity within that excerpt is believed to comprise Applicant's claimed "notarization service" nor identified what action described in the excerpt comprises that service "retrieving image data on behalf of a user". Regardless, because that portion, as well as the remainder of

the Epstein reference fails to teach the disclosed "retrieving", Epstein cannot be said to anticipate claim 1.

On page 9 of the Examiner's Answer, the Examiner further states that Epstein teaches a "viewer" for viewing a notarized image in column 5, lines 15-17. In reply, Applicant notes that a teaching of a view is *not* a teaching of a notarization service "retrieving imaging data on behalf of a user" as explicitly recited by Applicant. Unfortunately, the Examiner has again declined to provide an explanation of his position. Therefore, he has not identified how the existence of such a viewer is equivalent to a notarization service "retrieving" imaging data "on behalf of a user".

Also on page 9 of the Examiner's Answer, the Examiner argues that Epstein teaches in column 5, lines 22-29 that the viewer is from a server that the Examiner alleges to form part a notarization service. Applicant disagrees in that the described "server" is separate from the "notary host" explicitly described by Epstein. *See Epstein*, column 4, lines 41-57. Regardless, Epstein's teaching of a server having an image viewer is still not a teaching of a service "retrieving imaging data on behalf of a user" as explicitly recited by Applicant.

4.   **"From the User's Personal Imaging Repository"**

As noted in the Appeal Brief, Epstein does not teach that the retrieval of the claimed user imaging data is "from the user's personal imaging repository". Again, Epstein does not teach a service "retrieving" imaging data on behalf of a user. Moreover, Epstein does not even contemplate the concept of a "personal imaging repository".

On page 9 of the Examiner's Answer, the Examiner alleges that Epstein's server comprises the claimed "personal imaging repository". In reply, Applicant notes that nothing within Epstein's disclosure would lead someone to conclude that the server, which the Examiner previously defined as comprising part of a "notarization service," is the user's personal repository for images. For example, Epstein's server is not described by Epstein as a storage place for the user's images. Indeed, Epstein explicitly states that Epstein's server *deletes* the user's images after processing because they take up too much space. *Epstein*, column 5, lines 10-14. Clearly then, such a server cannot reasonably be considered to serve the same purpose of Applicant's disclosed and claimed personal imaging repository.

Furthermore, as per the Examiner's argument, Epstein's server "retrieves" the user's imaging data. If Epstein's server is also the claimed "personal imaging repository", it is the Examiner's position that the server "retrieves" the user's imaging data from itself. Within the plain and ordinary meaning of the term "retrieve" something cannot "retrieve," an entity from itself.

5.   "Retrieving . . . Via an Imaging Extension"

As noted in the Appeal Brief, Epstein also does not teach that retrieval of imaging data from the user's personal imaging repository is accomplished via an "imaging extension". Again, Epstein does not even contemplate a notarization service "retrieving" imaging data "on behalf of a user" or a the concept of "personal imaging repository". Moreover, Epstein says absolutely nothing about an "imaging extension".

On pages 9 and 10 of the Examiner's Answer, the Examiner notes that Epstein teaches that "a user requests the image for viewing on a viewer and the stored image is provided" in column 5, lines 15-17, and the Examiner argues that such a disclosure is a teaching of "retrieving" an image "via an imaging extension". Applicant submits that the Examiner's argument is vague and further contradicts the Examiner's own previously-stated position. Specifically, as noted above, the Examiner argues that Epstein's server "retrieves" imaging data "on behalf of a user". See Examiner's Answer, Section 2(a)(i), pages 8-9. Now, however, the Examiner appears to argue that it is the user who "retrieves" the image using Epstein's "viewer." First, Applicant submits that the Examiner cannot point to one entity of Epstein's disclosure as comprising a "notarization service" to account for one limitation and then point to a different entity as comprising that service when accounting for a different limitation. Instead, the Examiner should remain consistent in his position when addressing Applicant's claims. Second, the latter argument as to the user retrieving his own images makes no sense given that such a situation clearly would not be a "notarization service" retrieving the imaging data "on behalf of a user".

As a further matter, if it is the Examiner's position that Epstein's viewer comprises an "imaging extension", Applicant reiterates that Applicant indicates that the "imaging extension" is a component that is called upon to act as a gateway to access the user's personal imaging repository. Applicant's specification, page 9, line 11 to page 10, line 24. The term should be interpreted consistent with that definition. Markman v. Westview Instruments, Inc., 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), aff'd, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification,

of which they are a part"). In contrast, Epstein's "viewer" is merely a program that is used by the user to display images. It is not used to "retrieve" imaging data for a network-based notarization service and further is not used to retrieve such data from a "personal imaging repository". Indeed, because it is the author who is viewing the image, no such "imaging extension" is necessary. In other words, the author already knows the location of the image and already has authorization to access to it.

6. Dependent Claims

From the above, it is clear that claim 1 is allowable over Epstein. Given that claims 5-12, 29, and 31 incorporate the limitations of claim 1, these claims are allowable over Epstein for at least the same reasons. As noted in the Appeal Brief, however, many of the dependent claims contain further limitations that are not taught by Epstein.

Regarding dependent claims 5 and 13, Epstein does not teach that the imaging extension comprises "part of a user browser". Even if Epstein's "viewer" were interpreted to comprise an "imaging extension", *nowhere* does Epstein state that the viewer comprises part of a user browser. In reply to the Examiner's argument on pages 10 and 11 of the Examiner's Answer that the "viewer" *is* a browser, Applicant asserts that Epstein's viewer cannot be interpreted as a browser *and* "part of" a browser at the same time.

Regarding dependent claims 6 and 18, Epstein does not teach that the imaging extension comprises "part of the network-based notarization service". In particular, if Epstein's viewer is interpreted to comprise an "imaging extension", the viewer clearly does not form part of Epstein's "notary host." In reply to the Examiner's argument that

Epstein's server is part of a "notary service," Applicant asserts that there is no basis for that position. Again, Epstein explicitly identifies a "notary host" and a separate "server" that is never described by Epstein as part of a notary service.

Regarding dependent claims 10-12, 20, and 23, Epstein does not teach the concept of a "notarization certificate". In reply to the Examiner's identification of "information appended the image data", mere appending of data to an image does not result in the generation of a "certificate". In particular, no separate document, image, or file is generated through such appending.

7.   Claims 24 and 25

As noted in the Appeal Brief, Schreiber does not remedy the various deficiencies of the Epstein reference discussed in relation to claim 1. Applicant therefore submits that claims 24 and 25 are allowable over the Epstein/Schreiber combination for at least the same reasons that claim 1 is allowable over Epstein. Furthermore, with particular regard to the limitations of claim 24, Epstein's "viewer," which is relied upon by the Examiner as comprising the claimed "imaging extension", is not described as comprising an API.

Because Epstein fails to teach such an API, the Examiner relies upon the Schreiber reference. As noted in the Appeal Brief, however, Schreiber does not teach such an API and there is no legitimate motivation to modify Epstein's invention with the teachings of the Schreiber reference.

The Examiner argued in the final Office Action that Schreiber teaches an imaging extension in column 18, lines 19-38. As indicated in the Appeal Brief, that portion of the Schreiber reference provides as follows:

In a preferred embodiment, the present invention prevents a user from using Windows API functions, such as BitBlt, StretchBlt, PlgBlt, GetPixel and GDI32, to copy protected image data, by including software within the user's web browser that substitutes other functions for those Windows API functions. For example, the software within the user's web browser provides a substitute BitBlt function, which is invoked instead of the standard system BitBlt function when the user issues a command to copy data from the video display buffer. The substitute BitBlt function includes special logic for dealing with protected image data, but is otherwise identical to the standard system BitBlt function. The special logic serves to supply substitute pixel data instead of protected image data, so that the data that is copied to the user's clipboard is different from the raw pixel data of protected images. For example, the special logic can compose watermarks and/or a text message onto protected image pixel data, or it can encrypt protected image pixel data, or it can supply a completely white image instead of a protected image.

Schreiber, column 18, lines 19-38.

As is clear from that excerpt, Schreiber is describing APIs that are used to "copy protected image data" from web sites, *not* retrieve imaging data on the behalf of a user from the user's personal imaging repository. Therefore, Schreiber's APIs are not "imaging extensions" that perform the functions stated in Applicant's claims.

In reply to the Examiner's argument on page 14 of the Examiner's Answer that Applicant does not claim an imaging extension that retrieves imaging data, Applicant notes that because claim 24 depends from claim 1, claim 24 incorporates all of the limitations of claim 1. As stated above, claim 1 contains the limitation: "retrieving imaging data . . . via an imaging extension". Claim 24 further specifies that "the imaging extension

comprises application programming instructions (API)". Using simple logic, it follows that the API recited in claim 24 is used to retrieve the imaging data of claim 1.

As to the Examiner's motivation to combine stated on page 14 of the Examiner's Answer, Applicant notes that although Schreiber discusses copyright protected images, Epstein does not. Therefore, a person having ordinary skill in the art would not be motivated to provide aspects of Schreiber's disclosure relating to copyrighted images to Epstein's invention for the purpose of protecting images as alleged by the Examiner.

Turning to the particular limitations of claim 25, Applicant reiterates that neither Epstein nor Schreiber describe any "generic access instructions" that call upon an "imaging extension" to "access the user's personal imaging repository". On page 14 of the Examiner's Answer, the Examiner argues that "Schreiber teaches the well-known technique of accepting a generic command to access information". Applicant notes that the Examiner has not cited any portion of the Schreiber disclosure for support of that allegation. Furthermore, Applicant notes that the Examiner has ignored the explicit wording of claim 25. Specifically, claim 25 recites that "content is downloaded from the network-based notarization service to the user browser, the content comprising generic access instructions that call upon the imaging extension to access the user's personal imaging repository". If, as argued by the Examiner, Epstein's "viewer" comprises the claimed "user browser", the Examiner has failed to explain how "content" including the "generic access instructions" are downloaded to that viewer. Clearly, neither Epstein nor Schreiber teaches or suggests such an action.

8.   Rejection of Claims 26 and 27

As noted in the Appeal Brief, Braam does not remedy the deficiencies of the Epstein reference. Applicant therefore maintains that claims 26 and 27 are allowable over the Epstein/Braam combination for at least the same reasons that claim 1 is allowable over Epstein.
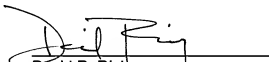
9.   Rejection of Claim 28

As noted in the Appeal Brief, Braam does not remedy the deficiencies of the Epstein reference. Applicant therefore maintains that claim 28 is allowable over the Epstein/Natarajan combination for at least the same reasons that claim 1 is allowable over Epstein.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

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